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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:)	Before the Examiner
)	William M. Pierce
Robert Toth)	
)	Group Art Unit 3711
Serial No. 10/617,993)	
)	
Filed July 11, 2003)	
)	
BOWLING TOURNAMENT METHOD)	February 13, 2006

TRANSMITTAL OF APPEAL BRIEF
PATENT APPLICATION -- 37 C.F.R. §41.37

Mail Stop Appeal Briefs-Patent
Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450

Sir:

1. Transmitted herewith is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on December 9, 2005.

2. STATUS OF APPLICANT

This application is on behalf of a small entity.

I hereby certify that, on the date shown below, this correspondence is being deposited with the United States Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 as "Express Mail Post Office to Addressee."

Express Mail Label No. EV746140476US

Sheryl L. Hutchings
Signature of Person Mailing

Sheryl L. Hutchings
Printed Name of Person Mailing

February 13, 2006
Date

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. §41.20(b)(2), the fee for filing the Appeal Brief is \$250.00.

4. EXTENSION OF TERM

None.

5. TOTAL FEE DUE

The total fee due is:

Appeal brief fee \$250.00

Extension fee (if any) \$0

TOTAL FEE DUE \$250.00

6. FEE PAYMENT

Authorization is hereby made to charge the amount of \$250.00 to the Credit Card as shown on the attached Credit Card information authorization form PTO-2038.

7. FEE DEFICIENCY

If any additional extension and/or fee is required, and/or if any additional fee for claims is required, charge the Credit Card as shown on the attached Credit Card information authorization form PTO-2038.

Respectfully submitted,

Date: February 13, 2006

By: 

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APPEAL BRIEF (37 C.F.R. §41.37)

Mail Stop Appeal Briefs-Patent
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P.O. Box 1450
Arlington, VA 22313-1450

Sir:

This Appeal Brief is in furtherance of the Notice of Appeal, filed in this case on December 9, 2005, and received by the US Patent and Trademark Office on December 12, 2005. The fees required under §41.20 are dealt with in the accompanying Transmittal of Appeal Brief.

I hereby certify that, on the date shown below, this correspondence is being deposited with the United States Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 as "Express Mail Post Office to Addressee."

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I. REAL PARTY IN INTEREST

(37 C.F.R. §41.37(c)(1)(i))

The real party in interest in this appeal is the Applicant, Robert Toth.

II. RELATED APPEALS AND INTERFERENCES

(34 C.F.R. §41.37(c)(1)(ii))

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal, there are no such appeals or interferences.

III. STATUS OF CLAIMS

(37 C.F.R. §41.37(c)(1)(iii))

The status of the claims in this application are:

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are 1-6.

B. STATUS OF ALL THE CLAIMS

1. Claims cancelled: None.
2. Claims withdrawn from consideration but not cancelled: None.
3. Claims objected to: None.
4. Claims allowed or confirmed: None.
5. Claims rejected: 1-6.

C. CLAIMS ON APPEAL

The claims on appeal are: 1-6.

IV. STATUS OF AMENDMENTS

(37 C.F.R. §41.37(c)(1)(iv))

There have been no amendments filed subsequent to final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

(37 C.F.R. §41.37(c)(1)(v))

Independent claim 1 claims a method for providing a one game scratch match play single elimination tournament for league players, comprising the steps of:

- a. providing a pool of eligible league players;
- b. placing each eligible league player into one of eight divisions, each division being defined by highest average scores attained by league players in current league play;
- c. conducting a local first round of competition in which each of the eligible league players in each of the eight divisions engages in one game scratch match play, single elimination, eight-player brackets, until one player prevails in each division and continues on to a regional second round;
- d. conducting a regional second round in 512 locations that are geographically distributed as equally as possible in which each of the eight divisions engages in one game scratch match play, single elimination, until one player prevails in each division and continues on to a championship round; and
- e. conducting a championship round in a single location in which each of the 512 league players who prevail in the regional second round in each of the eight divisions engages in one game scratch match play, single elimination, until 8 tournament champions prevail, one in each of the eight divisions.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
(37 C.F.R. §41.37(c)(1)(vi))

Claims 1-6 stand rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

VII. ARGUMENT – REJECTIONS UNDER 35 U.S.C. §101
(37 C.F.R. §1.192(c)(8)(iv))

The Examiner has finally rejected **claims 1-6** under 35 USC 101 as being directed to non-statutory subject matter.

In October, 2005, the United States Patent and Trademark Office issued *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility* (hereinafter “*Guidelines*”). The *Guidelines* are particularly relevant to this Appeal, as they go into detail on how an examiner is to determine “whether the claimed invention complies with the subject matter eligibility requirement of 35 U.S.C. §101.” *Guidelines* at 11.

In Annex I of the *Guidelines*, a flowchart for examiners is provided to be followed when reviewing applications. The steps set forth in the flowchart are:

1. Determine what the applicant has invented and is seeking to patent.
2. Conduct a thorough search of the prior art.
3. Determine whether the claimed invention complies with the subject matter eligibility requirements of 35 U.S.C. §101.
4. Evaluate the application for compliance with 35 U.S.C. §101.
5. Clearly communicate findings, conclusions and their bases.

As suggested by the title of the *Guidelines*, step 3, above, is the focus of the *Guidelines*, and of this Appeal.

In determining whether the claimed invention complies with the subject eligibility requirements of 35 U.S.C. §101, the examiner must follow four steps. First, the examiner must consider the breadth of 35 U.S.C. §101 under controlling law. Second, the examiner must determine whether the claimed invention falls within an enumerated statutory category (process, machine, manufacture or composition of matter). Third, the examiner must determine whether the claimed invention falls within a §101 judicial exception (laws of nature, natural phenomena, and abstract ideas), for which the guidelines give the greatest detail to examiners. Fourth, the examiner must establish on the record a *prima facie* case regarding eligibility of the subject matter. *Guidelines*, Annex I, at 11-24.

In determining whether the claimed invention falls within a §101 judicial exception, the Examiner must first ask whether the claim is directed to an abstract idea, a law of nature, or a natural phenomenon. The *Guidelines* suggest that the way to avoid these exceptions is for the claims to be directed to a practical application of a §101 judicial exception.

Therefore examiner should also determine whether the claimed invention involves a practical application of a judicial exception. A practical application of a judicial exception can be identified several ways, according to the *Guidelines*, but the *Guidelines* suggest two specific ways: First, either “the claimed invention ‘transforms’ an article or physical object to a different state or thing”; or second, “the claimed invention otherwise produces a useful, concrete and tangible result, based on certain factors.” *Guidelines* at 19. The *Guidelines* offer few specifics regarding the first alternative of identifying a practical application of a judicial exception. However, the second way is described in detail. Specifically, the *Guidelines* suggest, “In determining whether the claim is

for a ‘practical application,’ the focus is not upon whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is ‘useful, tangible and concrete.’” *Guidelines* at 20 (emphasis in original). The *Guidelines* give particular definitions of these last three terms. “Useful” includes results that are specific, substantial and credible, and specifically recited in the claim. “Tangible,” which is the opposite of abstract, means that the results must be some “real-world results.” “Concrete,” which is the opposite of unrepeatable or unpredictable, means that the results “can be substantially repeatable or the process must substantially produce the same result again.” *Guidelines* at 20-22.

Lastly, in determining whether the claimed invention falls within a statutory judicial exception, the examiner must decide whether the claim would actually preempt the use of a law of nature, natural phenomena, or abstract idea. For example, the applicant may not patent a process that comprises every “substantial practical application” of an abstract idea, because such a patent “in practical effect would be a patent on the [abstract idea] itself.” *Guidelines* at 23. “If an examiner determines that the claimed invention preempts a §101 judicial exception, the examiner must identify the abstraction, law of nature, or natural phenomena and explain why the claim covers every substantial practical application thereof.” *Guidelines* at 23.

Annex III to the *Guidelines* also lists five improper tests for subject matter eligibility, including the mental step or human step tests and the machine implemented tests. *Guidelines* at 42. For the purposes of determining whether a claimed invention is eligible subject matter, the *Guidelines* note that it is immaterial whether some or all of the steps of the claimed invention can be carried out by a human, including the human mind, or a machine. The keys to determining whether a claimed invention is a practical application of a §101 exception resides in two questions: (1) Does “the claimed invention physically transform an article or physical object to a different

state or thing,” *Guidelines* at 42, and (2) Is “the final result achieved by the claimed invention ... ‘useful, tangible and concrete.’” *Guidelines* at 20 and 42.

Applicant submits that the subject matter of his present application, a bowling tournament method, achieves a final result, namely, eight tournament champions prevailing after a one game scratch match play single elimination tournament for league players, which result is useful, tangible and concrete as required under the *Guidelines*. Applicant further asserts that the examiner’s tests used to deny subject matter eligibility to the claims of the present application were not processed under the *Guidelines*, even though the final Office Action was mailed on November 2, 2005, and as discussed above, Applicant’s subject matter is eligible for patentability under the *Guidelines*, principally because the final result achieved by the method of the present application is a useful, tangible and concrete result. It includes results that are specific, substantial and credible and specifically recited in the claim; the results are real-world results; and the results can be substantially repeatable and the process will substantially produce the same results again and again and again.

VIII. APPENDIX OF CLAIMS

(37 C.F.R. §41.37(c)(1)(viii))

The text of the claims involved in the appeal are:

1. A method for providing a one game scratch match play single elimination tournament for league players, comprising the steps of:
 - a. providing a pool of eligible league players;
 - b. placing each eligible league player into one of eight divisions, each division being defined by highest average scores attained by league players in current league play;

c. conducting a local first round of competition in which each of the eligible league players in each of the eight divisions engages in one game scratch match play, single elimination, eight-player brackets, until one player prevails in each division and continues on to a regional second round;

d. conducting a regional second round in 512 locations that are geographically distributed as equally as possible in which each of the eight divisions engages in one game scratch match play, single elimination, until one player prevails in each division and continues on to a championship round; and

e. conducting a championship round in a single location in which each of the 512 league players who prevail in the regional second round in each of the eight divisions engages in one game scratch match play, single elimination, until 8 tournament champions prevail, one in each of the eight divisions.

2. The method of claim 1 wherein the providing step includes defining eligible league players as those who have paid weekly tournament entry fees over a league season.

3. The method of claim 1 wherein the placing step includes placing eligible league players into one of eight divisions based upon each player's highest average in the current league season based upon at least 60 games.

4. The method of claim 1 wherein the placing step includes placing eligible league players into one of eight divisions based upon each player's highest average in the last three years or highest lifetime league average based upon at least 60 games.

5. The method of claim 1 wherein the providing step includes discretionarily defining eligible league players at the local league level.

6. The method of claim 1 wherein the placing step includes eight divisions based on average bowling scores, including one division for average scores of 215 or more; one for average scores between 200 and 214; one for average scores between 185 and 199; one for average scores between 170 and 184; one for average scores between 155 and 169; one for average scores between 140 and 154; one for average scores between 125 and 139; and one for averages less than 124.

IX. APPENDIX OF EVIDENCE
(37 C.F.R. §41.37(c)(1)(ix))

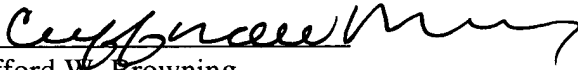
None.

X. APPENDIX OF RELATED DECISIONS
(37 C.F.R. §41.37(c)(1)(x))

None.

Respectfully submitted,

Date: February 13, 2006

By: 
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